

REMARKS

Claim Rejections

Claims 12-20 are rejected under 35 U.S.C. § 103() as being unpatentable over Pruett et al. (6,263,440) in view of Lam et al. (5,545,583).

Double Patenting

The Examiner's withdrawal of the double patenting rejection is noted.

Claim Amendments

By this Amendment, Applicant has canceled claims 17-18 and has amended claim 12 this application. Claim 1 has been amended to include the subject matter of claims 17 and 18. It is believed that the new claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The cited reference to Pruett et al. teaches a system for tracking and protecting display monitors by reporting their identity that includes a computer (10) having a power supply (17), a power button (21), a first chipset (44), a CPU host bus (42), and a second chipset (52). The second chipset is connected to a PCI bus (50), which is also connected to the CPU host bus and the first chipset.

As noted by the Examiner, on page 4 of the outstanding Office Action, Pruett does not teach the flash memory array. Pruett et al. does not teach the flash memory controller and the flash memory array being electrically connected to a circuit board; nor does Pruett et al. teach the flash memory controller and the flash memory array being enclosed in a casing.

Additionally, Pruett et al. teaches the flash memory interface being a chip, but unlike the present invention does not teach the flash memory controller being an MX9691 controller. Absent written documentation Applicant respectfully traverses Examiners conclusion that the chip taught in Pruett et al. is equivalent to the MX9691 controller of the present invention.

The cited reference to Lam et al. recites a method of making a semiconductor trench capacitor cell having a buried strap.

Lam et al. states, at col. 2, lines 17-21:

There exists a continuing demand for semiconductor memory device designs and processes which utilize fewer processing sequences, while at the same time facilitating greater storage capacity and allowing more densely packed memory arrays.

In the background of the invention, Lam et al. states that there is continuing demand for memory arrays. However, Lam et al. does not teach a flash memory array having a plurality of flash memories. Applicant respectfully traverses the cited reference as teaching memory arrays absent written documentation. Further, Lam et al. does not teach a power source, an IDE interface, or a flash memory controller.

Even if the teachings of Pruett et al. and Lam et al. were combined, as suggested by the Examiner, the resultant combination does not suggest: 1) a flash memory array having a plurality of flash memories; 2) the flash memory controller and the flash memory array being electrically connected to a circuit board; nor does the combination teach 3) the flash memory controller and the flash memory array being enclosed in a casing.

On page 4 of the outstanding Office Action, the Examiner admits that the reference to Pruett et al. does not teach a flash memory array, and cites the secondary reference to Lam et al. as teaching it in "the abstract". Applicant submits that there is not the slightest suggestion in either Pruett et al. or Lam et al. of combining the flash memory array with the remainder of the elements as specifically set forth in Applicant's claims. It is a basic principle of U.S. patent law that it is

Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

There is not the slightest suggestion in either Pruett et al. or Lam et al. that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Pruett et al., nor Lam et al. disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious the amended claims.

Summary

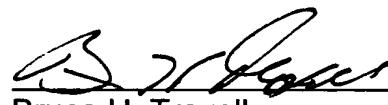
In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that the amendment be entered for the purposes of appeal. It is not believed that the foregoing amendments to claim 12 require any further searching and/or consideration on the part of the Examiner, since such amendments merely include the language of canceled claims 17-18 into claim 12. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of claims 17-18.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

Date: October 31, 2003

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